

Amendment dated 03/13/2006
In Response to Final Office Action mailed 01/13/06

U.S.S.N. 09/887,824
005222.00145

REMARKS

Claims 1-9, 19-27, and 37-45 are pending with this paper. Claims 1-17 and 19-54 stand rejected by this Office Action. There are no rejections of claim 18. Applicant is canceling claims 10-18, 28-36, and 46-54 without prejudice.

Applicant acknowledges withdrawal of the objections to claims 12, 15, 19, 21, and 32. Applicant acknowledges withdrawal of the rejection of claim 18 under 35 U.S.C. §112. Applicant acknowledges withdrawal of the rejections of claims 1-6, 10-15, 19, 28, 37, 38, and 46 under 35 U.S.C. §102. Currently, there are no prior art rejections.

Regarding the §101 rejections, Applicant acknowledges the Examiner's withdrawal of arguments (corresponding to Arguments 1 and 2 presented by the Office Action on pages 10-11) regarding whether the claims are practiced on a computer. Because the §101 issues raised in paragraphs 1-18 of this Office Action reiterate the issues presented in the previous office action dated July 27, 2005, Applicant is basing this paper on a response to new issues presented in this Office Action that correspond to Arguments 3-14 (pages 11-21).

Because the §112 issues raised in paragraphs 19-23 of this Office Action reiterate the issues presented in the previous office action dated July 27, 2005, Applicant is basing this paper on a response to new issues presented in this Office Action that correspond to Arguments 15-16 (pages 21-24).

Applicant is canceling claims 10-18, 28-36, and 46-54 without prejudice. Applicant is amending claims 1, 19, and 37.

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Other Amendments

Applicant is amending claim 1 to replace "provide" with "providing" in order to correct a typographical error.

Claim Rejections - 35 U.S.C. § 101

Claims 1-17 and 19-54 are directed to non-statutory subject matter.

Applicant is amending claim 1 to include the features of "receiving a goal, the goal in a specific task being associated with a training objective of a student in a business simulation application," "integrating information that motivates accomplishment of the goal by the student," and "adjusting the feedback based on progress of the student toward the goal to help the student complete a business deliverable." (Emphasis added.) Claim 19 is amended to include the similar features of "presenting information indicative of a goal, the goal in a specific task being associated with a training objective of a student in a business simulation application," "integrating information that motivates accomplishment of the goal by the user in a simulated environment goal for use in the presentation," and "monitoring progress toward the goal and providing feedback that further motivates accomplishment of the goal in the simulated environment to help the student complete a business deliverable." The above amendments are supported by the application as originally filed, e.g., (Page 12, lines 27-30):

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A good way to gain better appreciation for how the BusSim Toolset can vastly improve the BusSim development effort is to walk through scenarios of how the tools would be used through the development lifecycle of a particular task in a BusSim application. For this purpose, we'll assume that the goal of the student in a specific task is to journalize invoice transactions, and that this task is within the broader context of learning the fundamentals of financial accounting.

Regarding Argument 3 and claim 1, the Office Action alleges (Page 12.):

Applicant asserts that "the claimed goal is not abstract but is associated with a training objective of a student." That assertion is insufficient to limit the claims to statutory material.

The fundamental issue is: Did Applicant limit the claims to a practical application?

Specifically, the topic of "associating" "a goal," of unspecified scope, with a "training objective of a student," also of unspecified scope, is a "field of use" that encompasses an undefined scope of invention ... it is not a practical application limiting the claims to a defined scope of invention.

As amended, claim 1 includes the feature of "receiving a goal, the goal in a specific task being associated with a training objective of a student in a business simulation application" and "adjusting the feedback based on progress of the student toward the goal to help the student complete a business deliverable." (Emphasis added.) The specified scope of "goal" is "in a specific task" and the specified scope of "training objective of a student" is "in a business simulation application." Moreover, the claim is directed to a practical application with a "specific task," a "business simulation application," and a "business deliverable." The Office Action further alleges (Page 13.):

Even if Applicant is trying to say that the presentation's effect on the student causes a physical effect on the student, Applicant has not specified the desired effect...

However, claim 1 is directed "to help the student complete a business deliverable" and consequently specifies the desired effect.

Regarding Argument 4 and claim 10, the Office Action alleges (Page 14.):

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Applicant's word "Logic" refers to nothing but a Boolean algorithm. Claiming that it is used for achieving an unspecified "goal" or "training objective" adds nothing to the basic Boolean equation. Taking several abstract variables (i.e., the claimed "goal" or the claimed "training objective") and manipulating those abstract variables through Boolean logic brings no statutory material to the claim.

While Applicant is canceling claim 10 without prejudice, claim 10 is directed to statutory matter for at least the reasons presented for Argument 3.

Regarding Argument 5 and claim 19, the Office Action alleges (Page 14.):

Again, Taking several abstract variables (i.e., the claimed "goal" or the claimed "business objective") and manipulating those abstract variables through Boolean logic brings no statutory material to the claim.

Claim 19 is directed to statutory material for at least the reasons presented for Argument 3.

Regarding Argument 6 and claim 28, the Office Action alleges (Page 15.):

Applicant's word "Logic" refers to nothing but a Boolean algorithm. (Claiming that it is used for achieving an unspecified "goal" or "training objective" adds nothing to the basic Boolean equation. Taking several abstract variables (i.e., the

for at least the reasons presented for Argument 3.

Regarding Argument 7 and claim 28, the Office Action asserts (Pages 15-16.):

Notice that Applicant asserts in his definition of the word "associate" that:

"...a plain meaning of "associate" is..."

Notice further that he did not say:

"...the plain meaning of associate is..."

There were several possible meanings of the word "associate" in reference Applicant cites. Applicant chooses one of those meanings of the word "associate" in the reference Applicant cites. Applicant chooses one of those meanings and presents it as the one he intended all along.

Although this selection of the meaning of the word "associate" is not in the Specification or Claims, Examiner accepts this meaning as prosecution history estoppel as to what meaning was intended by Applicant. Therefore, the

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association is not a pointer association or a nomenclature association or any association other than one that arises from merely "accompanying" the student objective ... whatever that means, or being "concomitant" with the student objective...whatever that means.

Regardless, such a disclosure is still insufficient to define a practical application (i.e., to provide a statement of what the invention actually is.)

As previously discussed, Applicant is amending claims 1, 19, and 37 to clarify what is being claimed. For example, claim 1 includes the feature of "receiving a goal, the goal in a specific task being associated with a training objective of a student in a business simulation application." In Applicant's response to the Office Action mailed July 27, 2005, the words of the claim must be given their plain meaning unless Applicant has provided a clear definition in the specification in accordance with MPEP § 2111.01. (Applicant notes that MPEP § 2111.01 refers to "their plain meaning" and not "the plain meaning".) For example, a plain meaning of "associate" is "following or accompanying; concomitant." (The American Heritage College Dictionary, Third Edition, Houghton Mifflin Company.) Moreover, as discussed with Argument 3, the claims are limited to practical applications. Applicant believes that the words of claim 1, as amended and in accordance with their plain meaning, are clear and limit the claim to statutory subject matter.

Regarding Argument 8 and claim 28, the Office Action alleges (Pages 16-17.):

The fundamental issue is: Did Applicant limit the claims to a practical application? Specifically, the topic of "associating" a goal, of unspecified scope, with a "training objective of a student," also of unspecified scope, is a "field of use" that encompasses an undefined scope of invention...it is not a practical application limiting the claims to a defined scope of invention.

As discussed with Argument 3, the claims are directed to a practical application.

Regarding Argument 9 and claim 10, the Office Action alleges (Pages 18-19. Emphasis added.):

Applicant asserts that the word "motivates" does not describe a mental state... apparently to show that it is "real world." Applicant makes the apparent

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implication that the word "motivates" describes some sort of real world physical state of motivation akin to the word "impel."

If the motivation is not mental, then the only clear alternative is some sort of physical implication, in order to satisfy §101.

Applicant's implication is remarkable: Does Applicant imply that the claimed invention physically impels or "motivates" students through a goal? Examiner doubts that and believes that the "impelling" or motivating" is actually a mental experience, rather than some sort of physical flinging or catapulting experience, as implied by Applicant.

If the motivation is not mental, and it is not physical, then what else is it? Applicant does not say.

The physical impelling of students through a goal makes no sense, at least to most

Therefore, Examiner maintains his interpretation that Applicant's word "motivates" is a pure human thought and the rejection is not withdrawn.

While Applicant is canceling claim 10 without prejudice, the issues presented by the Office Action are similar to the issues presented in Argument 12. Applicant respectfully notes that claim 10 includes the feature of "logic that integrates information that motivates accomplishment of the goal." The Office Action is altering the feature by referring to motivating student through a goal. Moreover, the Office Action appears to equate the meaning of "impel" to "flinging" or "catapulting" even though "impel" is commonly understood to denote "to urge to action." (The American Heritage College Dictionary, Third Edition, Houghton Mifflin Company.) As will be discussed, Applicant is amending claims 1, 19, and 37 to clarify what is being claimed.

Regarding Argument 10, the Office Action alleges (Page 20.):

The fundamental issue is: Did Applicant limit the claims to a practical application? Specifically, the topic of "associating" a "goal," of unspecified scope, with a "training objective of a student," also of unspecified scope, is a "field of use" that encompasses an undefined scope of invention...it is not a practical application limiting the claims to a defined scope of invention.

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The issues presented by the Office Action are addressed with the discussion for Argument 3.

Regarding Argument 11, the Office Action alleges (Page 20.):

Applicant asserts that: "The goal is not associated with an algebraic word problem, a Boolean logic problem, a fuzzy logic algorithm, a probabilistic word problem, a philosophies idea, or vague expression."

Well, if that is Applicant's wish, Examiner will accept the stipulation that the goal has not association "with an algebraic word problem, a Boolean logic problem, a fuzzy logic algorithm, a probabilistic word problem, a philosophies idea, or a vague expression."

Again, this estoppel does not solve the issue of what the practical application is.

The issues presented by the Office Action are addressed with the discussion for Argument 3.

Regarding Argument 12 and referring to claims 1-54 and Argument 9, the Office Action alleges (Page 21.):

Again, Examiner does not believe the "motivation" or "impelling" in this argument is a physical event and believes it describes a mental state that does not provide statutory matter to the claim.

As discussed with Argument 9, the claims are not directed to a mental state of a student. In order to clarify what is being claimed, Applicant is amending claim to include the feature of "integrating information that motivates accomplishment of the goal by the student." (Emphasis added.) The amendment is supported by the specification as originally filed. For example, the specification discloses (Page 3, line 37- page 4, line 6. Emphasis added.):

Figure 2 is a block diagram of a system architecture in accordance with a preferred embodiment. The Presentation 'layer' 210 is separate from the activity 'layer' 220 and communication is facilitated through a set of messages 230 that control the display specific content topics. A preferred embodiment enables knowledge workers 200 & 201 to acquire complex skills rapidly, reliably and consistently across an organization to deliver rapid acquisition of complex skills. This result is achieved by placing individuals in a simulated business environment that "looks and feels" like real work, and challenging them to make decisions which support a business' strategic objectives utilizing highly effective learning theory (e. g., goal based learning, learn by doing, failure based learning, etc.), and the latest in multimedia user interfaces, coupled with three powerful, integrated software components.

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Claim 1 is not directed to a mental state of the student but rather is directed to an effect on the student as manifested, for example, by the system shown in Figure 2...Claim 12 is amended to by the user in a simulated environment goal for use in the presentation." Claim 37 is amended to include the similar feature of "integrating information that provides assistance with achieving the goal, by the plurality of students, into a tutor for use in the presentation."

Regarding Argument 13 and referring to claims 1, 19, and 37, the Office Action alleges (Page 21.):

The fundamental issue is: Did Applicant limit the claims to a practical application? Specifically, the topic of "associating" a "goal," of unspecified scope, with a "training objective of a student," also of unspecified scope, is a "field of use" that encompasses an undefined scope of invention...it is not a practical application limiting the claims to a defined scope of invention.

The issues presented by the Office Action are addressed with the discussion for Argument 3.

Regarding Argument 14 and referring to claims 10, 28, and 46, the Office Action alleges (Page 22.):

Applicant's word "Logic" refers to nothing but a Boolean algorithm. Claiming that it is used for achieving an unspecified "goal" or "training objective" adds nothing to the basic Boolean equation. Taking several abstract variables (i.e., the claimed "goal" or the claimed "training objective") and manipulating those abstract variables through Boolean logic brings no statutory material to the claim.

While Applicant is canceling claims 10, 28, and 46 without prejudice, claims 10, 28, and 46 is directed to statutory matter for at least the reasons presented for Argument 3.

For at least the above reasons, Applicant requests reconsideration of claims 1-9, 19-27, and 37-45.

Claim Rejections - 35 U.S.C. § 112

Claims 1-17 and 19-54 are rejected by the Office Action under 35 U.S.C. 112. The Office Action alleges that claims 1-54 are rejected under 35 U.S.C. 112, first paragraph

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"because current case law (and accordingly, the MPEP) require such a rejection if a 101 rejection is given".

Regarding Argument 15 and referring to claims 1-54 the Office Action alleges (Page 22.):

Applicant made no persuasive arguments that overcome the 101 [rejections], therefore, there is no basis for withdrawing the 112 [rejections], first paragraph rejections either.

As discussed above, Applicant requests withdrawal of the rejections under §101 and consequently the rejections under §112, first paragraph.

Claims 1-17 and 19-54 are rejected by the Office Action under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter with applicant regards as the invention.

Regarding Argument 16 and referring to claims 1-54 the Office Action alleges (Pages 23-24.):

So, the goal "accompanies" the student objective...in some way. Is this some sort of physical accompaniment? If so, what kind?

Yes, Applicant goes to the dictionary and finds one of the myriad definitions of associate there and selects it as the one that was intended all along, but even that definition is vague in this claim context. In fact, it is unclear what this really means. Does this mean that one has a basketball hoop (goal) that is somehow accompanying the student objective of getting a basket. Does it mean that one has a finish line tape (goal) that is somehow accompanied by the student objective of finishing the race quickly? Does it mean that once has a solution set to some math problems (goal) that is somehow accompanying the goal of problem solving?

If the answer is all of the above, then we have a word that refers to multiple invention and is at [at] the very least ambiguous, if not vague.

Yes, Applicant was able to find a definition for the word "associate" in the dictionary (otherwise, it wouldn't be in the language, right?) but that word does not specify the scope of the invention...it is vague as to what it refers in the patent sense.

As previously discussed, Applicant is amending claim 1 to include the feature of "receiving a goal, the goal in a specific task being associated with a training objective of a student in a business simulation application." As amended, the claim limits the scope of the invention and

clearly does not include a goal of a "basket hoop" or a "finish line tape." Independent claim 19 includes a similar feature of "presenting information indicative of a goal, the goal in a specific task being associated with a training objective of a student in a business simulation application. Also, claim 37 is amended to include the feature of "receiving indicia representative of a goal into a model, the goal in a specific task being associated with a training objective of a plurality of students in a business simulation application." Applicant respectfully submits that the claims are definite and distinct in claiming the subject matter that Applicant regards as the invention in light of the plain meanings of the words. Applicant requests reconsideration of claims 1-9, 19-27, and 37-45.

All objections and rejections have been addressed. Hence, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is earnestly solicited.

Respectfully submitted,

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